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10/608,468	06/27/2003	William Pugh	Google-5/CON1 (GP-016-01-	9373
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

*		Application No.	Applicant(s)	•		
		10/608,468	PUGH ET AL.			
	Office Action Summary	Examiner	Art Unit	,		
		Merilyn P. Nguyen	2163			
Period fo	The MAILING DATE of this communication app or Reply	ears on the cover sheet with the	correspondence	address		
A SHOWHIC WHIC - Exter after - If NO - Failu Any I	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. Period for reply is specified above, the maximum stautory period we to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing and patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be solution will expire SIX (6) MONTHS from cause the application to become ABANDON	DN. timely filed m the mailing date of thi IED (35 U.S.C. § 133).			
Status						
2a)⊠	Responsive to communication(s) filed on <u>23 M</u> . This action is FINAL . 2b) This Since this application is in condition for allowar closed in accordance with the practice under E	action is non-final. nce except for formal matters, p		the merits is		
Dispositi	on of Claims					
5)⊠ 6)⊠ 7)□ 8)□ Applicati	Claim(s) <u>46-67</u> is/are pending in the application 4a) Of the above claim(s) is/are withdraw Claim(s) <u>46-47</u> is/are allowed. Claim(s) <u>48-67</u> is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or ion Papers The specification is objected to by the Examine	vn from consideration. r election requirement. r.				
	The drawing(s) filed on <u>27 June 2003</u> is/are: a) Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Ex	drawing(s) be held in abeyance. S ion is required if the drawing(s) is c	ee 37 CFR 1.85(a) objected to. See 37	CFR 1.121(d).		
Priority u	under 35 U.S.C. § 119					
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
2) Notice 3) Information	et(s) te of References Cited (PTO-892) te of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO/SB/08) tr No(s)/Mail Date	4) Interview Summa Paper No(s)/Mail 5) Notice of Informal 6) Other: <u>Detailed ac</u>	Date Patent Application			

1. In response to the communication dated 03/23/2007, claims 46-67 are pending in this

application.

2. This application is a continuation of 09/768947 now patent numbered 6,658,423.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and

requirements of this title.

3. Claims 48-67 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

As set forth in MPEP 21 06(II)A:

Identify and understand Any Practical Application Asserted for the Invention The

claimed invention as a whole must accomplish a practical application. That is, it must produce a

"useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The

purpose of this requirement is to limit patent protection to inventions that possess a certain level

of "real world" value, as opposed to subject matter that represents nothing more than an idea or

concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383)

U.S. 519, 528-36, 148 USPQ 689, 693-96), In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPO2d

1600, 1603-06 (Fed. Cir. 199334. Accordingly, a complete disclosure should contain some

indication of the practical application for the claimed invention, i.e., why the applicant believes

the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Maher Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application").

Claimed invention (Claims 48 and 67) recites a machine-readable medium having stored thereon a plurality of records which do not satisfy the useful result aspect of the practical application requirement. Merely claiming nonfunctional descriptive material stored in a machine-readable medium does not make the invention eligible for patenting. The claims recite functional descriptive hash function, which is used to hash each of the elements to determine which one of the plurality of list that each of the elements will be contained in. However, the determination is performed outside of the machine-readable medium and is nothing to do with the functional aspect of the medium. Thus, merely reciting non-functional descriptive material (field and lists) by putting them into memory does not lead to a practical application.

Claimed invention (Claim 49) recites a method for determining whether two documents are near-duplicates comprising for each of the two documents, generating at least two fingerprints and determining whether or not the two documents are near-duplicates document which do not provide useful and tangible results as to whether their execution accomplishes a practical application. This claim contains software per se which is not tangible. Moreover, the claim lack of practical application as to how the system would operate if it is determined that the fingerprint of the first of the two documents does not match with the fingerprint of the second of the two documents. The newly added limitation does not resolve the lacking of practical application because the determination of whether or not the two documents are near-duplicates is intended to use for different operations but not actually involving any function at all.

Claimed invention (Claims 50-67) recites a machine-readable medium having stored thereon a plurality of records which do not satisfy the useful result aspect of the practical application requirement. Merely claiming nonfunctional descriptive material stored in a machine-readable medium does not make the invention eligible for patenting. Merely reciting non-functional descriptive material such as field and lists by putting them into memory does not lead to a practical application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 4. Claim 49 is rejected under 35 U.S.C. 102(e) as being anticipated by Broder (US 6,119,124).

Regarding claim 49, Broder discloses a method for determining whether two documents are near-duplicates (See col. 4, line 6 et seq.), the method comprising:

- a) for each of the two documents, generating at least two fingerprints (See col. 4, lines 19-24, wherein unique identifications of a document can be computed as digital fingerprints corresponding to at least two fingerprints for each document); and
 - b) determining whether or not the two documents are near-duplicate documents by

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i) determining whether or not any one of the at least two fingerprints of a first of the two documents matches any one of the at least two fingerprints of a second of the two documents (See col. 10, lines 27-29), and

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- ii) if it is determined that anyone fingerprint of the at least two fingerprints of the first of the two documents does match any one fingerprint of the at least two fingerprints of the second of the two documents, then concluding that the two documents are near-duplicates (See 10, lines 27-29); and
- c) using the determination of whether or not the two documents are near-duplicates in at least one of (A) an act of serving search results corresponding to documents, (B) an act of crawling documents, (C) an act of indexing documents (See col. 2, lines 27-30), and (D) an act of fixing a broken link to at least one of the two documents.
- 5. Claims 50-54, 58-60, 61-63, and 64-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (U.S. Patent No. 5,850,490).

Regarding claims 50-54, Johnson discloses a machine-readable medium having stored thereon a plurality of records (See Fig. 16), each of the records comprising:

- a) a first field for storing a document identifier (Document Identifier field 0001, Fig. 16); and
 - b) a plurality of lists (Segment class 1, segment class 2, segment class 3..., Fig. 16), each of the plurality of lists containing elements of a document identified by the document identifier stored in the first field ("Cowherds of the Deep" for example, Fig. 16, wherein, words in "Cowherds of the Deep" corresponding to elements of a document),

Johnson teaches a plurality of records organized into a table; each record reflects a document at Fig. 16, entry 452, wherein each record having plurality of segment classes (lists). Since a document may not have the same keywords with other documents, therefore, some of the Segment classes 1, 2, 3 include no keyword (element). Thus, Johnson teaches wherein at least some of the plurality of lists include different numbers of elements and wherein at least one of the plurality of lists include no elements as per claims 50 and 51.

Johnson teaches wherein contiguous elements in a document are not necessarily contiguous elements of a list as one having ordinary skill in the art would have recognized that table in Fig. 16 stores plurality of Segment classes for keywords in documents thus keywords in document are not necessarily contiguous in key fields as per claim 52.

Johnson teaches wherein for each of the records, the number of lists is the same as each of records has the same number of segment classes as per claim 53. Since each document may have the same keywords with other documents or may not have the same keywords with other documents, however, document records still have the same number of segment classes (list) range from 1 to ... in the table; therefore, Johnson teaches wherein a number of the plurality of lists is independent of document size as per claim 54.

Regarding claims 58, 61 and 64, Johnson teach discloses wherein each of the elements of a document is an element that has been extracted from the document (See col. 20, lines 20-31).

Regarding claims 59, 62 and 65, Johnson discloses wherein each of the elements of a document is a predetermined one of (A) a predetermined number of words (See col. 20, lines 28-

31, for example, "It was a dark"), (B) a predetermined number of sentences, (C) a predetermined number of characters, (D) a predetermined number of paragraphs, and (e) a predetermined number of sections.

Regarding claims 60, 63 and 66, Johnson discloses wherein each of the elements of a document partially overlaps another of the elements of the document (See col. 20, lines 28-31)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 6. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 5,850,490), in view of Fujiwara (U.S. Patent No. 6,381,601).

Regarding claim 48, Johnson discloses a machine-readable medium having stored thereon a plurality of records (See Fig. 16), each of the records comprising:

- a) a first field for storing a document identifier (Document Identifier field 0001, Fig. 16); and
 - b) a plurality of lists (Segment class 1, segment class 2, segment class 3..., Fig.16), each of the plurality of lists containing elements of a document identified by the document identifier stored in the first field ("Cowherds of the Deep" for

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example, Fig. 16, wherein, words in "Cowherds of the Deep" corresponding to elements of a document),

However, Johnson is silent as to teach wherein a hash function is used to hash each of the elements in order to determine which of the plurality of lists that each of the elements will be contained in. On the other hand, Fujiwara teaches using a hash function to hash each of the elements in order to determine which of the plurality of lists that each of the element will be contained in (See col. 2, lines 57-62, col. 4, lines 47-62, col. 5, line 50 to col. 6, line 10, Fujiwara et al. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a hash function to hash each of the elements in order to determine which of the plurality of lists that each of the element will be contained in. The motivation would have been to reduce or remove duplicate elements by using hash function.

7. Claims 48, 55-57, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judd (U.S. Patent No. 6,360,215), in view of Fujiwara (U.S. Patent No. 6,381,601).

Regarding claim 48, Judd discloses a machine-readable medium having stored thereon a plurality of records (Index 16, Fig. 1 and col. 6, lines 47-48 and lines 66-67), each of the records comprising:

- a) a first field for storing a document identifier (col. 7, lines 45-46, wherein location identifier of the current document corresponding to "document identifier" and wherein document index record corresponding to "record"); and
 - b) a plurality of lists, each of the plurality of lists containing elements of a document identified by the document identifier stored in the first field (See col. 7,

lines 45-50, wherein columns (lists) of record contain values of properties (elements of document) such as document title, document summary. One having ordinary skill in the art would have recognized that document title or document summary would contain words, characters or sentences),

Judd teaches MD5 hash function (See col. 7, line 65 to col. 8, line 9). However, Judd is silent as to teach wherein a hash function is used to hash each of the elements in order to determine which of the plurality of lists that each of the elements will be contained in. On the other hand, Fujiwara teaches using a hash function to hash each of the elements in order to determine which of the plurality of lists that each of the element will be contained in (See col. 2, lines 57-62, col. 4, lines 47-62, col. 5, line 50 to col. 6, line 10, Fujiwara et al. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a hash function to hash each of the elements in order to determine which of the plurality of lists that each of the element will be contained in. The motivation would have been to reduce or remove duplicate elements by using hash function.

Regarding claim 55, Judd/Fujiwara discloses wherein each of the elements of a document is an element that has been extracted from the document (See col. 7, lines 48-50, Judd et al.).

Regarding claim 56, Judd/Fujiwara discloses wherein each of the elements of a document is a predetermined one of (A) a predetermined number of words (See col. 7, lines 48-50, "document title", "document summary", Judd et al.), (B) a predetermined number of sentences (See col. 7, lines 48-50, "document summary", Judd et al.), (C) a predetermined number of

characters, (D) a predetermined number of paragraphs, and (e) a predetermined number of sections.

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Regarding claim 57, Judd/Fujiwara discloses wherein each of the elements of a document partially overlaps another of the elements of the document (See co. 7, lines 47-50, Judd et al.).

Regarding claim 67, this claim recites similar subject matter as set forth above in claim 48, thus is rejected under similar ground.

8. Claims 50-54, 58-60, 61-63, and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates (U.S. Patent No. 6,873,982), in view of Johnson (U.S. Patent No. 5,850,490).

Regarding claims 50-54, Bates discloses a machine-readable medium having stored thereon a plurality of records (See Fig. 4), each of the records comprising:

- a) a first field for storing a document identifier (Document Identifier field 102, Fig. 4); and
 - b) a plurality of lists (Key 1...Key N, reference 106, Fig. 4), each of the plurality of lists containing element of a document identified by the document identifier stored in the first field (See col. 9, lines 1-3),

Bates teaches each of the plurality of lists containing one element of a document. However, Bates is silent as to each of the plurality of lists containing elements of a document. On the other hand, Johnson teaches each of the plurality of lists containing elements of a

document (See Fig. 16, and corresponding text, Johnson). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have each of the plurality of lists containing more than one element of a document as suggested by Johnson because the difference are only found in the nonfunctional descriptive material and do not alter how the elements of system function. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Bates teaches a plurality of records organized into a table, each record reflects a document at Fig. 4 and col. 6, lines 33-45, wherein each record having plurality of keyword fields (lists). Since a document may not have the same keywords with other documents, therefore, some of the key fields 106 include no keyword (element). Thus, Bates teaches wherein at least some of the plurality of lists include different numbers of elements and wherein at least one of the plurality of lists include no elements as per claims 50 and 51.

Bates teaches wherein contiguous elements in a document are not necessarily contiguous elements of a list as one having ordinary skill in the art would have recognized that table in Fig. 4 stores plurality of key fields for keywords in documents thus keywords in document are not necessarily contiguous in key fields as per claim 52.

Bates teaches wherein for each of the records, the number of lists is the same as each of records has the same number of key 1 to key N fields as per claim 53. Since each document may have the same keywords with other documents or may not have the same keywords with other documents, however, document records still have the same number of key fields (list) range from

1 to N in the table; therefore, Bate teaches wherein a number of the plurality of lists is independent of document size as per claim 54.

Regarding claims 58, 61 and 64, Bates/Johnson discloses wherein each of the elements of a document is an element that has been extracted from the document (See col. 9, lines 2-3, Bates et al.)

Regarding claims 59, 62 and 65, Bates/Johnson discloses wherein each of the elements of a document is a predetermined one of (A) a predetermined number of words, (B) a predetermined number of sentences (C) a predetermined number of characters (word contain predetermined character, col. 9, lines 2-3), (D) a predetermined number of paragraphs, and (e) a predetermined number of sections.

Regarding claims 60, 63 and 66, Bates/Johnson discloses wherein each of the elements of a document partially overlaps another of the elements of the document (See Fig. 4).

Response to Arguments

9. Applicant's arguments filed on 48-67 about the claim rejection of the last Office Action have been fully considered, but they are not persuasive.

Regarding Applicant's argument on the 101 rejection of claims 48, 50, 52, 53 and 67,

Applicant argues that these claims are more than a mere abstraction and the claimed data structures are specific structural elements in memory. However, merely stored data structures in

memory and merely claiming nonfunctional descriptive material stored in a machine-readable medium does not make the invention eligible for patenting. The claims do not satisfy the useful result aspect of the practical application requirement as to whether their execution accomplishes a practical application.

Applicant argues that Broder does not teach concluding that two documents are near-duplicates if any one fingerprint of one of the documents matches any one fingerprint of the other document where each of documents has at least two fingerprints. The Examiner respectfully disagrees. Broder teaches each of documents has at least two fingerprints at col. 2, lines 34-38 and col. 4, lines 19-24, wherein the set of shingles associated with a document are reduced to unique identifications, unique identifications of a document can be computed as digital fingerprints corresponding to at least two fingerprints for each document of the Applicant. And Broder teaches two documents are near-duplicates if any one fingerprint of one of the document matches any one fingerprint of the other document at col. 1, lines 4-7 ("like data objects can be identified") and col. 10, lines 27-29 ("if two documents with identical fingerprints are encountered").

Applicant argues that Johnson does not teach a plurality of lists, each of the plurality of lists containing elements of a document. The Examiner respectfully disagrees. Figure 16 teaches this limitation as each of the records (record 452) of table 450 contains a plurality of lists (Segment class 1 corresponds to title, segment class 2 corresponds to author, segment class 3 corresponds to text...), then each of the plurality of lists containing elements of a document, for example, segment class 3 corresponds to text that begins with the words (words corresponds to elements) "It was a dark...").

Applicant argues that one skilled in the art would not have been motivated to combine Johnson with Fujiwara. The Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Fujiwara hash function is used to group data in records that belongs to particular column (See col. 2, lines 57-62). And Johnson groups the correct data (such as title belong to Segment class 1) to corresponding column. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine Johnson with Fujiwara.

Applicant argues that Judd fail to appreciate how any of these elements can be characterized as lists. Examiner respectfully disagrees. Col. 7, lines 45-50 states, "Each index record also contains the location identifier of the **current document**, and may also contain values of properties...such as **document** title, **document** summary", therefore location identifier, title and summary belongs to "the current document".

Allowable Subject Matter

10. Claims 46 and 47 are allowed.

Regarding claims 1 and 11, the prior art of record fail to disclose or suggest the claimed limitation of: comparing a cluster identifier of the one candidate search results with a cluster

identifier of the other candidate search result to determine that the one candidate search result is a near-duplicate of the other candidate search results so that the one candidate search result is rejected, thereby a filtered set of search results including only those of the plurality of candidate search results that have not been rejected in conjunction with the remaining, salient claim provisions.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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June 08, 2007

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